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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/648,508 | 08/25/2003 | Frank T. Brzozowski | | 4230 |
| 44321 | 7590 | 02/15/2006 | EXAMINER | |
| PATRICIA A. WENGER 201 NORTH JACKSON STREET MEDIA, PA 19063 | | | MAI, HUY KIM | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2873 | |

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,508

Applicant(s)

BRZOZOWSKI, FRANK T.

Examiner

Huy K. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-38 and 46-85 is/are pending in the application.
- 4a) Of the above claim(s) 74-76 and 85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-38, 46-58, 62, 64-69, 72, 73 and 77-84 is/are rejected.
- 7) ☒ Claim(s) 59-61, 63, 70 and 71 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Huy K. Mai
Huy K. Mai
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. In response to the restriction requirement filed Jan. 3, 2006, the applicant elects claims 34-38, 46-73 and 77-84 for examination without prejudice. Claims 74-76 and 85 are withdrawn from consideration as being non-elected invention. As of record, the summary interview, paper # 1205 mailed Jan. 5, 2006 indicates that "it was agreed that Applicant would be called once there is a determination of allowability for all examined claims to provide Applicant the opportunity to amend withdrawn claims 74-76 and 85 to depend from an allowed examined claims provided that there are no 112 issues resulting from such an amendment".

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 36,37,46-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations "said lens further comprising peripheral member" (claim 36, line 2) are indefinite because the lens and the peripheral member are two separate elements. The lens cannot comprise of the peripheral member. Similarly, the limitations "said lens further comprising at least one memory member" are also indefinite.

Regarding claims 46,78, the phrase "*consisting essentially of ...*" was held to be indefinite because the specification contains guidelines that were considered sufficient to enable a person of ordinary skill in the art to draw a line between unavoidable impractical in using the rotatable

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lens in the air such as airplane pilot eyewear and essentially using deep in the sea such as deep sea diving eyewear as claimed. In re Marosi, 710 F.2d 799, 218 USPQ 289 (CCPA). The court further observed that it would be impractical to require applicant to specify a particular number as a cutoff between their invention and the prior art.

The remaining claims are dependent upon the above rejected base claims and thus inherit the deficiency thereof.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 34-36,46 are rejected under 35 U.S.C. 102(b) as being anticipated by Erhard (1,401,327).

Regarding claims 34-36, Erhard, in Figs 1-4, page 1, column 1, line 38 through column 2, line 69, discloses eyeglasses comprising a lens 5,6,7,8 and a peripheral member 2 wherein the friction in contact between the user's finger and the edge of the lens to cause the lens rotate relative to the peripheral member 2. Thus, the Erhard'd eyeglasses inherently included a rotator and/or a turning member.

Regarding claim 46, Erhard discloses an eyewear system comprising a containment structure 2, at least one lens 5,6,7,8 being rotatable within the containment structure 2 wherein the friction in contact between the user's finger and the edge of the lens to cause the lens rotate relative to the peripheral member 2. Thus, the Erhard'd eyeglasses inherently included a rotator.

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6. Claims 38,46,47,49,50 are rejected under 35 U.S.C. 102(b) as being anticipated by Karasawa (5,663,779).

Regarding claim 38, Karasawa discloses, in Fig.6, the lens 56 comprising an anchor cut-out 104. Regarding claim 46,47,49,50, Karasawa discloses in Figs. 5-10, a configurable eyewear system, said eyewear system comprising at least one containment structure 11 and at least one lens 56, said at least one lens being rotatable within said containment structure, said eyewear system further comprising at least one rotator 102,243, said at least one lens being rotatable at least by said rotator.

7. Claims 46,51-55,77,78,80-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey (1,471,996).

The limitations in claims 46,51-55,77,78,80-84 are shown in Bailey's Figs. 1-7, pages 1-2. bailey discloses a configurable eyewear system, said eyewear system comprising at least one containment structure 7 and at least one lens 1, said at least one lens being rotatable within said containment structure, said eyewear system further comprising one turning member 4, said at least one lens being rotatable at least by said turning member 4, said system further comprising at least one peripheral member 3, said turning member 4 being attached to said peripheral member 3, and wherein said at least one lens further comprises a peripheral edge, said peripheral edge having at least one mating member, said at least one peripheral member 3 having at least one mating member, said peripheral member mating member engaging said peripheral edge mating member (see Fig. 6).

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Regarding claims 51,80, the containment structure including the bridge and/or guide 8 wherein the operating member 9 slides the turning member 4 between first position (see Fig. 3) and the second position (see Fig. 4). Thus the guide 8 inherently includes a stop member.

8. Claims 77, 80 are rejected under 35 U.S.C. 102(b) as being anticipated by Archambault (2,813,459).

The limitations in claims 77,80 are shown in Archambault's Figs. 1-7, columns 1-2. Archambault discloses an eyewear system comprising a containment structure 7 and at least one lens 13 rotatable within the containment structure wherein the containment includes two stop members (see Fig.3).

9. Claims 34,37,46,57,58,62 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Tassier (5,956,114).

Regarding claim 34,46, the limitations in claims 34,37 are readable over Tassier's Figs. 1,4,8. Tassier discloses an eyewear lens 11 freely rotatable within the frame 2. any shake or touch and push on the surface of the lens cause the lens rotates. Thus surface of the lens can be considered a rotator.

Regarding claims 37,57,58,62,64 and 72, the magnetic means 15 and 17, in Tassier's Fig. 8, magnetically attach to each other and pull the lens back to the original position. Thus the magnets do the function as a memory member.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 48,52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erhard.

Erhard discloses a configuration eyewear system comprising at least one containment structure 2 and at least one lens being rotatable with in the containment structure 2. wherein the containment structure having an interior surface and the lens having a peripheral edge (see Fig. 4). The interior surface and the peripheral edge have complement shapes. Although the interior surface and the peripheral edge in the Erhard's eyewear system does not teach the exact the shape of bezel as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Erhard reference by interior surface and the peripheral edge having the same shape as the applicant's. Such a modification would have no functional differences from the Erhard reference.

12. Claim 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Archambault in view of Hirschman (6,227,666).

Archambault discloses the claimed invention as discussed above. However, Archambault is silent in how the lens 13 being mounted in the ring 12. A lens is mounted in a ring or rim by a split rim mounting is commonly known in the art as taught by Hirschman, for example; wherein the rim is split with two ends having projections connecting together after mounting the lens. Therefore it would have been obvious at the time the invention was made to those having ordinary skill in this art to modify the Archambault's device by forming a split at the projection 18 for mounting the lens 13 in the rim 12 as a common knowledge in the art. Such a modification would not change the scope of the invention disclosed by Archambault.

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13. Claims 65-69,73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tassier.

Regarding claims 65-69, absence in showing the new or unobvious results and the reasons why the connector comprised of gluing, molding, heat sealing, tacking or an anchor insert for connecting the memory means to the lens, it would have been an obvious engineering choice to form such connectors for connecting the memory means to the lens.

Regarding claim 73, absence in showing the new or unobvious results and the reasons why the memory means having an anchor end, it would have been an obvious engineering choice to form such an anchor end for attaching the memory means to the lens.

Allowable Subject Matter

14. Claims 59,60,63,70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

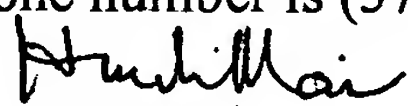
15. Claims 61,71 are objected to as dependent upon the above objected claim.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00 a.m.-4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.


Huy Mai
Primary Examiner
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HKM/
February 10, 2006